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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/075,073	02/13/2002	William Glen Harter	A0000428-01-CFP	7569

28880 7590 11/25/2003

WARNER-LAMBERT COMPANY
2800 PLYMOUTH RD
ANN ARBOR, MI 48105

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/075,073

Applicant(s)

HARTER ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 27-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-24, and 27-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Applicant's amendment of 9-15-03 is acknowledged. Because of the broad subject matter claimed herein, the following restriction is required for a proper search and examination.

Claims 1-24, and 27-52 are pending.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 5, 12, 18, 23, 24, 41, and 45-47, drawn to compounds of formula I with W and its attached carbons forming a substituted 5-membered ring with **1 nitrogen** atom in the ring (i.e., a substituted **pyrrolo**), or compounds of formula V; also pharmaceutical composition thereof.

classified in classes 514, 544, and 548, various subclasses depending on substituents.
 - II. Claims 1, 2, 23, 24, 41, 46, and 47, drawn to compounds of formula I with W and its attached carbons forming a substituted 5-membered ring with **2 nitrogen** atoms in the ring (e.g., a substituted **imidazolo**); also pharmaceutical composition thereof,

classified in classes 514, 544, and 548, various subclasses depending on substituents.
 - III. Claims 1, 2, 4, 11, 15, 18, 23, 24, 41, 44, 46, and 47, drawn to compounds of formula I with W and its attached carbons forming a substituted 5-membered ring

with only **1 oxygen** atom in the ring (i.e., a substituted **furo**), or compounds of formula IV; also pharmaceutical composition thereof.

classified in classes 514, 544, and 549, various subclasses depending on substituents.

- IV Claims 1-3, 6-10, 13-22, 41-43, 46, and 47, drawn to compounds of formula I with W and its attached carbons forming a substituted 5-membered ring with only **1 sulfur** atom in the ring (i.e., a substituted **thieno**), or compounds of formulae II, and III; also pharmaceutical composition thereof.

classified in classes 514, 544, and 549, various subclasses depending on substituents.

- V. Claims 1, 2, 23, 24, 41, 46, and 47, drawn to compounds of formula I with W and its attached carbons forming a substituted 5-membered ring with **1 nitrogen** atom, and **1 sulfur** atom in the ring (i.e., a substituted **thiazolo**); also pharmaceutical composition thereof,

classified in classes 514, 544, and 549, various subclasses depending on substituents.

- VI. Claims 1, 2, 23, 24, 41, 46, and 47, drawn to compounds of formula I with W and its attached carbons forming a substituted 5-membered ring with **1 nitrogen** atom, and **1 oxygen** atom in the ring (i.e., a substituted **oxazole**); also pharmaceutical composition thereof,

classified in classes 514, 544, and 549, various subclasses depending on substituents.

- VII. Claims 27-40, and 48-52, drawn to **various methods of use or treatment**, classified in class 514, various subclasses depending on the substituents. Further restriction will be required if this group is elected.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of groups I to VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to compounds of different formulae and various methods of treatment.

- a. The compounds of Groups I-VI do not share the same core or technical feature. The compounds of Group I have a core of a bicycle having 3 nitrogen atoms in the ring. The compounds of Group II have a core of a bicycle having 4 nitrogen atoms in the ring. The compounds of Group III have a core of a bicycle having 2 nitrogen atoms, and 1 oxygen atom in the ring. The compounds of Group IV have a core of a bicycle having 2 nitrogen atoms, and 1 sulfur atom in the ring. The compounds of Group V have a core of a bicycle having 3 nitrogen atoms, and 1 sulfur atom in the ring. The compounds of Group VI have a core of a bicycle having 3 nitrogen atoms, and 1 oxygen atom in the ring. Thus, each group has a different ring system for a core, and is patentably distinct over each other.

b. Although the compounds of Groups I-VI share the ring of *1,2,3,4-tetrahydro-pyrimidine*, such a ring alone does not define the invention, and is not applicant's contribution to the art. It is the combination of the *1,2,3,4-tetrahydro-pyrimidine* **fused** with the ring having W, and all the attached variables that sets apart the compounds of each group. Thus, a reference anticipated the compounds of one group would not do so to the others. Therefore, a separate search is required for each group, which poses a burden of searching.

c. The invention of Group VII is drawn to various methods of use and/or treatment using compounds in Groups I-VI. For a set of compounds, each method of use or treatment will require a separate search since a reference read on one method would not do so to the others. Again, a burden of searching exists for the search of each method of use or treatment.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II-VII due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A voice message was left for Mr. Claude Purchase on 11-20-03 regarding the above restriction requirement, and Mr. Purchase called back to indicate that a written restriction was preferred.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (7 am -12 pm, and 3 pm - 6 pm) starting from 10-1st -03.

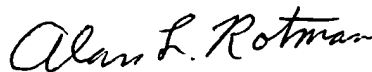
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

November 21, 2003



ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
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